

REMARKS

In the Official Action of December 31, 2002, pending claims 1, 3-6, and 8-20 were rejected. Applicant files this response that addresses the rejections noted in the communication. The present response is fully responsive to the Official Action of December 31, 2002.

35 USC 112 REJECTION OF CLAIMS 8, 12, AND 14

Claims 8, 12 and 14 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claims 8, 12, and 14 to address the indefiniteness. As such, the 35 USC 112, second paragraph, rejection of claims 8, 12, and 14 as been traversed.

35 USC 102 REJECTION OF CLAIMS 1, 3-6 AND 8-20

Claims 1, 3-6, and 8-20 were rejected under 35 USC 102(b) as being anticipated by Taylor et al (US 4,440,221).

MPEP §2131 provides:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).MPEP §2131 provides:

Taylor et al fails to describe each and every element of pending claims 1, 3-6 and 8-20.

With reference to amended independent claim 1, one such element that is not found in Taylor et al is a “sleeve in the body selectively positionable at and between an open position and a closed position adapted to regulate the flow.” With reference to amended independent claim 5, one such element Taylor et al fails to disclose is a “sleeve valve selectively positionable at and between an open position and a closed adapted to regulate flow.” With reference to amended independent claim 12, one such element Taylor et al fails to disclose is “means for choking, at and between full flow and no flow.” With reference to amended independent claim 13, one such element

Taylor et al fails to disclose is “selectively choking, at and between full choke and no choke.” With reference to amended independent claim 14, one such element Taylor et al fails to disclose is “a valve in the body moveable to selectively choke at and between no choke and full choke.” With reference to amended independent claim 15, one such element Taylor et al fails to disclose is “a choke selectively positionable at and between an open position and a closed position adapted for controlling flow.” With reference to amended independent claim 20, one such element Taylor et al fails to disclose is “providing a choke selectively positionable at and between an open position and a closed position in the valve to selectively choke the fluid flow.”

In contrast to the above cited limitations, Taylor et al describes a safety valve that operates in either a fully open position or a fully closed position. There is no express or inherent disclosure in Taylor et al of a selectively positionable sleeve valve adapted to regulate/control flow.

Accordingly, for at least the above reason, the 102(b) rejection of claims 1, 3-6, and 8-20 is traversed and the claims are allowable.

35 USC 102 REJECTION OF CLAIMS 1, 3, 5, 6 AND 8-20

Claims 1, 3, 5, 6, and 8-20 were rejected under 35 USC 102(b) as being anticipated by Tamplen et al (US 4,473,122).

MPEP §2131 provides:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).MPEP §2131 provides:

Tamplen et al fails to describe each and every element of pending claims 1, 3, 5, 6 and 8-20.

With reference to amended independent claim 1, one such element that is not found in Tamplen et al is a “sleeve in the body selectively positionable at and between an open position and a closed position adapted to regulate the flow.” With reference to amended independent claim 5,

one such element Tamplen et al fails to disclose is a "sleeve valve selectively positionable at and between an open position and a closed adapted to regulate flow." With reference to amended independent claim 12, one such element Tamplen et al fails to disclose is "means for choking, at and between full flow and no flow." With reference to amended independent claim 13, one such element Tamplen et al fails to disclose is "selectively choking, at and between full choke and no choke." With reference to amended independent claim 14, one such element Tamplen et al fails to disclose is "a valve in the body moveable to selectively choke at and between no choke and full choke." With reference to amended independent claim 15, one such element Tamplen et al fails to disclose is "a choke selectively positionable at and between an open position and a closed position adapted for controlling flow." With reference to amended independent claim 20, one such element Tamplen et al fails to disclose is "providing a choke selectively positionable at and between an open position and a closed position in the valve to selectively choke the fluid flow."

In contrast to the above cited limitations, Tamplen et al describes a safety valve that prevents fluid flow while conducting hydraulic workover or snubbing operations. Thus, the safety valve of Tamplen et al operates in either a fully open position or a fully closed position. There is no express or inherent disclosure in Tamplen et al of a selectively positionable sleeve valve adapted to regulate/control flow.

Accordingly, for at least the above reason, the 102(b) rejection of claims 1, 3, 5, 6, and 8-20 is traversed and the claims are allowable.

**OBVIOUSNESS-TYPE DOUBLE PATENTING OVER CLAIM 1-46 AND 51-61 OF
COPENING APPLICATION NO. 09/441,701.**

Claims 1, 3-6, and 8-20 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 and 51-61 of copending U.S. Application No. 09/441,701, filed November 16, 1999. A terminal disclaimer has been executed and attached herewith to overcome the rejection. Accordingly, claims 1, 3-6, and 8-20 should be in condition for allowance.

OBJECTION TO THE SPECIFICATION

The specification has been amended to overcome the objections cited in Paragraph 10 of the Official Action.

Applicant respectfully requests reconsideration and that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Tim Curington", with a long horizontal stroke extending to the right.

Tim Curington
Reg. No. 45,944

Tim Curington
Schlumberger Technology Corporation
14910 Airline Road
PO Box 1590
Rosharon, Texas 77583-1590
281-285-5846
281-285-5537 fax